REMARKS

I.   Rejection

The Examiner has rejected claims 1 – 26, 45 – 51, 61 – 70, and 75 – 78 under 35 U.S.C. § 03(a) as being patentable over Frauenhofer et al., U.S. Patent No. 6,236,991 (hereinafter *Frauenhofer*) in view of Herz et al., U.S. Patent No. 5,754,939 (hereinafter *Herz*). This rejection is respectfully traversed.

II.   Introduction

One aspect of the claimed invention is that information sources (those who have information) can search for users who desire that information. This is in direct opposition to the traditional method of obtaining information on the Internet where the user must find a web site and then download what the user is looking for. Thus, in operation, a user would, for example, post an inquiry, such as, "What is playing at the Strand?" In this scenario, the Strand can respond with its playbill or it may decide not to respond at all. If the user inquires (records a request) such as, "What theater is showing XYZ movie?" then any theater playing the XYZ movie is free to respond to that user if it so desires. Note that in both examples, the requester who desired the information did not search for the source of the information. Rather, the source found the requester. As will be discussed below, this concept is the reverse of the concept taught by the *Frauenhofer* reference.

III.   Arguments

Turning now to the Examiner's specific rejections. With respect to the first element (a) of claim 1, the Examiner has stated:

> recording a request from a user pertaining to information content desired
> by the said user (e.g., "collecting and categorizing customized user
> profiles" see the abstract, "creating a user profile", see col. 2 (lines 25 and
> 66-67), col. 3 (line 5), col. 5 (line 8), col. 6 (line 38))

The *Frauenhofer* reference is directed to gathering profiles of users so that those profiles can be used to match against information gathered into a server. In such a system, it is contemplated that the requesting user desires to have all information within such a profile continuously delivered (or at least available for delivery) to that user. Thus, a user who

wishes to have sports scores delivered every hour would have a profile called, for example, "SPORTS." FIGURE 2 of *Frauenhofer* shows examples (called channels) of such profiles. This profile type information is also the subject matter of the *Herz* reference.

One aspect of a *Frauenhofer* profile is that it is <u>predefined</u> by the system and all of the information on the network within that category, filtered only by the user or an agent (server) of the user, is delivered to the user. In addition, the profiles of *Frauenhofer* contemplate the continuous provision of data to the user in keeping with the profile. This is in contrast to the recorded requests of the instant invention which (as will be discussed below) contemplate that the information will be obtained as a result of a determination <u>by a third party</u> that the third party has the information desired by the user. Thus, the inventive concept, in one aspect, is directed to the user asking for specific information, not broad concepts, as would occur with the profiles of the *Frauenhofer* and *Herz* references. Thus, as discussed in the instant specification, for example on page 4, line 6 et seq., the information requested can be a desired TV show, or a desired series, or the date on which a certain play will be in town, or a certain biography. By way of illustration, assume the user desires to know when a circus is coming to town. Using the *Frauenhofer* system, what profile would that user use to find that information? Assume there was a profile called "CIRCUS," and the user signed up for CIRCUS. In such a situation, the Server would search the web and track down whatever information was available pertaining to circuses. The information found by the Server would be made available to the user. Perhaps by chance, the user would also receive among that data the date of the next circus. Thus, when a user requires specific or focused information, profiles as defined by *Frauenhofer* and *Herz*, do not serve the purpose.

With respect to element (b) of claim 1, the Examiner has stated:

> accessing the recorded request by any information provider (sources 11, content providers 12, "actively collect and categorize ...content for delivery ...", see the abstract, col. 2, lines 1-27

In *Frauenhofer*, the information is <u>gathered</u> by the *Frauenhofer* system (the user) and then stored in relation to the profiles. The portions of *Frauenhofer* that the Examiner points to for support show just the opposite, namely that it is the *Frauenhofer*

server that goes and collects and categorizes the information from the various sources. For example, *see* col. 2 beginning at line 48 where *Frauenhofer* states:

> The System Server 10, gathers electronic content from content providers, as well as directly from sources, if necessary."

As discussed above, it is clear that the Server searches the Internet to find and gather information that matches the profile. Nothing in *Frauenhofer* even hints of a system or method where the information provider (the source or content providers of *Frauenhofer*) "accesses said recorded request" as specifically claimed. The Examiner has not addressed this aspect of the claim.

In the *Frauenhofer* reference, the user's agent, as discussed above, is Server 10. The claimed invention turns this around and it is the <u>provider</u> who searches for a user. Thus, clearly, claim 1 is directed to the **reverse** of the cited reference. As noted above, the Examiner has not addressed such a reversed operation.

The *Herz* reference is directed to the establishment of user profiles and to the protection, or privacy, of those files. The *Herz* reference is not directed to how the information is delivered to the user and thus, *Herz* does not teach or suggest that the information provider controls the information flow.

With respect to element (c), the Examiner has stated:

> determining by said accessing information provider whether or not the information said access[s]ing provider has control of matches the information content requested by the user (matching and delivering categorized information to customized user profiles, see the abstract, col. 2, col. 3, line 15, and col. 6, lines 55-59)

As discussed above, in the *Frauenhofer* reference the local server (System Server 10), not the information source, matches the collected data against all of the profiles. The *Frauenhofer* reference makes this operation abundantly clear. For example, at Col 5, beginning at line 6 it states:

> In all three implementations, the customer location would retain the capability for receipt of user request input, creation and storage of the user profile, matching of the user profile to the categories or channels into

which the documents are placed, and provision of the matched documents
for end user review.

Clearly then in *Frauenhofer* it is the customer (or user) which does the matching. The
accessing provider makes no determination as specifically called for in claim 1.

Accordingly, since neither *Frauenhofer* nor *Herz*, either separately or in combination,
suggest a system or method where an information provider accesses stored requests, it is
respectfully requested that claim 1 be held allowable.

The Examiner, in his Paragraph 2, stated that the *Frauenhofer* reference did not
explicitly mention the exact term or phase of the claims but disclosed the gist of the
invention. The Examiner then goes on to say that the differences in language are obvious
given his conclusion that the inventions are the same. This remark by the Examiner is not
accurate and begs the question, since, as discussed above, the differences in language
between the claims and the *Frauenhofer* reference yield a different operation, i.e. a **reversed**
operation. Thus, neither *Frauenhofer* nor *Herz* disclose the "gist" of the invention. It is
language, and only language, that defines inventive concepts. Thus, for the Examiner to
acknowledge that the language is different, but still reject the claims (even when the language
yields a reverse operation) without at least discussing how the difference in language yields
the same concept, is not a proper rejection of the claim.

The Examiner has rejected claim 3 by pointing to connections between users and
suppliers. As discussed above, in both the *Frauenhofer* and *Herz* references, it is the server
(user) who goes out for the information. Claim 3 contemplates that it is the supplier that goes
after the user and establishes the connection. In *Frauenhofer*, the user establishes the
connection to the provider. Again, as discussed above, this is a concept reverse from that
taught by *Frauenhofer* and *Herz*. Accordingly, claim 3 should be held allowable.

The Examiner has rejected claim 6 by saying that *Frauenhofer* teaches interaction
between providers and users. The Examiner points to *Frauenhofer* Col. 5, line 14. However,
line 14, discusses the relationship between the user and the Server in terms of interacting.
Frauenhofer does not discuss interacting between the Server and information sources in any
manner and specifically not "as to the nature of the information to be delivered" as

specifically recited in claim 6. In the context of *Frauenhofer*, the information providers are Source 11 and Content Provider 12. *Frauenhofer* does not show any interaction between elements 11 (12) and user 16. It is Server 10 (or possibly Server 14) which controls the information flow of the *Frauenhofer* system, not the information provider, as specifically claimed. Accordingly, claim 6 should be held allowable

The Examiner lumped claims 7-19 together with a blanket statement:

> As to claims 7-19, while Herz et al. disclosed the user's profile interest summaries to generate a user-customized rank ordered listing of target objects most likely to be of interest to each other so that the user can select from among these potentially relevant target objects ..., Herz et al. however, did not explicitly detail about the time of delivery, types of media for delivery, content of delivery, location of delivery, location of the user, location of a provider, etc. It would have been obvious to one of ordinary skill in the art at the time the invention was made to recognize that such detail features would have been a matter of programming choices and therefore these features are not patentably disting[h]uishable features.

Claims 7 – 19 are directed to a variety of different combinations, many of which the Examiner did not address. Thus it is impossible to respond properly to the Examiner's broad reaching statement saying that it is a matter of "programming choice." However, in the spirit of moving this application to issue, applicant will address these claims individually. However, if the Examiner persists in his rejection of claims 7 – 19, the Examiner is requested to please apply the prior art specifically to each claim so that applicant has a chance to properly respond. In addition, if the Examiner does apply the prior art to claims 7 – 19, any such rejection should not be made Final since it will be Applicant's first opportunity to respond to a specific rejection with respect to these claims.

Claim 7 details several aspects of the interaction between the provider and the user. Since, as discussed with respect to claim 6, the *Frauenhofer* reference does not address such provider accessing in any manner, it would follow that the *Frauenhofer* reference does not address access in the specific manners recited in claim 7. Also, since the Examiner rejected claim 6 in view of *Frauenhofer*, and claim 7 in view of *Herz*, there is a major inconsistency here, since that would imply that these claims are rejected on the combination of *Herz* and *Frauenhofer*. However, *Herz* does not address the user interacting with the provider to

determine the content of the information and the Examiner has not said otherwise. Thus, since the Examiner has stated that *Herz* does not address the specific limitations of claim 7 and *Herz* does not address interacting with the provider, it is hard to see how the limitations of claim 7 could be held to be "mere programming choices." Accordingly, claim 7 should be held allowable.

The examiner did not address claim 8 in any manner. Claim 8 is directed to using different media for each direction of communication. Neither *Frauenhofer* nor *Herz* addresses this in any manner, and the Examiner has not said otherwise. Therefore, calling this a "program choice" is not a proper rejection. Accordingly, claim 8 should be held allowable.

Claim 9 is directed to making adjustments for time, location or media. Again, for the Examiner to say this is a "programming choice" when neither *Frauenhofer* nor *Herz* addresses this concept in any manner is not a proper rejection. Accordingly, claim 9 should be held allowable.

Claim 10 is directed to adjusting for context. Again, for the Examiner to say this is a "programming choice" when neither *Frauenhofer* nor *Herz* addresses this concept in any manner is not a proper rejection. Accordingly, claim 10 should be held allowable.

Claim 11 is directed to adjusting for location of the user. Once again, for the Examiner to say this is a "programming choice" when neither *Frauenhofer* nor *Herz* addresses this concept in any manner is not a proper rejection. Accordingly, claim 11 should be held allowable.

Claim 12 is directed to entertainment media which is not in any manner addressed in the *Frauenhofer* and *Herz* references. Accordingly, claim 12 should be held allowable.

The concepts claimed in claims 13, 14, 15, 16, 17 are simply not taught by either of the *Frauenhofer* or *Herz* references and the Examiner has not said otherwise. To say that these concepts are "mere programming choices" is not a proper rejection when the underlying references do not even suggest such operations. Accordingly, claims 13, 14, 15, 16 and 17 should be held allowable.

Claim 19 is directed to future events not yet planned. This is a concept far different than anything discussed or even hinted at in the *Frauenhofer* and *Herz* references. To say that this concept is a "mere programming choices" is not a proper rejection when the underlying references do not even suggest this concept. Accordingly, claim 19 should be held allowable.

Claim 76 is directed to sending an e-mail message that information is available. Neither the *Frauenhofer* nor the *Herz* references send email messages to alert a user that information is available. Of even more importance, however, neither of those references even hint at such messages coming from the <u>source</u> of the information as claimed. Accordingly, claim 76 should be held allowable.

Claim 77 is directed to sending a wireless message that information is available. Neither the *Frauenhofer* nor the *Herz* references send wireless messages to alert a user that information is available. Again, neither of those references even hint at such messages coming from the <u>source</u> of the information as claimed. Accordingly, claim 77 should be held allowable.

For the reasons discussed above, claims 20-26 should also be held allowable. Separate arguments are not herein provided since the Examiner did not provide separate reasons for rejecting these claims.

The Examiner rejected claim 44 but did not provide any reasons therefore other than the reasons set forth for claims 1-19. Claim 44 recites "abstracts" of desired information inputted by a user. The cited references accept data from a user and form profiles therefrom. Thus, even assuming for the sake of argument that a profile and abstract are the same, the methods by which this information gets into the system are very much different. In the references, the user inputs data and a server (or other device) establishes a profile. In claim 44, the user inputs the abstract and the information source accesses the profile. Thus, this element is not taught by the cited references.

Claim 44 also states:

means operative from time to time for allowing any party other than said
user to have access to said abstract of said desired information

Nothing in the *Frauenhofer* or *Herz* references even hints at any third party gaining

access to the abstract and the Examiner has not said otherwise.

Claim 44 further recites:

means for allowing those of said other parties having information fulfilling
said abstracted information to deliver to said user said fulfilling
information

As discussed above, nothing in the *Frauenhofer* or *Herz* references even hints at the

third party delivering information which fulfills the abstract. In *Frauenhofer*, the information

is collected by the user (or the user's Server) and then made available to users dependent

upon the user's profile. In claim 44, it is the information provider which controls the

transaction and not the user (or the user's server) as taught by *Frauenhofer*. Accordingly,

unlike prior art systems, in the claimed invention it is the provider who controls when and to

whom information flows. In the prior art, as shown by *Frauenhofer*, information is put onto

a network, or made available to a network, and the person who wants that information must

find it and pull it down. Thus, in the prior art, the information provider is passive after

making the information available to the network. In claim 44, the information provider is

active in order to find a user who desires the information. Accordingly, since claim 44 is

directed to a concept different from the reference, claim 44 should be held allowable.

Claims 45 – 49 should be held allowable for reasons set forth above for other

dependent claims having similar elements.

Claim 50 is directed to delivering the information in a media consistent with the

user's ability to receive such information. The Examiner has not pointed to any prior art that

teaches such a concept. Accordingly, claim 50 should be held allowable.

Claim 51 is directed to controlling who can access the abstract of the desired

information. Nothing in the *Frauenhofer* or *Herz* references allows for third party access of

the profiles (even assuming the profiles are the same as the abstracts) and the Examiner has

not stated otherwise. Accordingly, claim 51 should be held allowable.

Claims 61 – 70 should be held allowable for the reasons set forth above with respect to claims 44-51.

Applicant has added new claims 81 – 95. New claim 81 is directed to entertainment information, which is a subset of "information" as set forth in claim 1. Claim 81 has four elements, three of which are present in claim 1. Thus, for the reasons set forth with respect to claim 1, newly added claim 81, as well as the claims dependent therefrom, should be held allowable.

New claim 86 is directed to TV users recording requests pertaining to programs. Claim 86 contains four elements, three of which are present in claim 1. Thus, for the reasons set forth with respect to claim 1, newly added claim 86, as well as the claims dependent therefrom, should be held allowable.

With respect to entertainment information and particularly TV and TV requests, the Examiner's attention is directed to the reference cited by the Examiner, namely Rothmuller, U.S. Patent No. 6,075,526 (hereinafter *Rothmuller*). The *Rothmuller* patent is directed to a method and system for sorting and searching a television program guide based on user profiles. The system of *Rothmuller* allows a user to input a program and then finds the airtime of that program. Nothing in *Rothmuller* teaches that a party other than the user may access the inputted information for any reason and particularly not for the purpose of determining whether or not a program is available. Accordingly, claim 86, and the claims dependent therefrom, should be held allowable.

IV.   Restriction Requirement

The Examiner has withdrawn claims 52 – 60 as being drawn to a separate invention. The Examiner is requested to please review and reconsider this restriction since claims 52 – 60 are directed to a method of delivering information from a provider to a requesting user. This concept is the same as claim 1, except approached from the information provider perspective as opposed to the user's prospective. The same prior art search covers both sets of claims.

V.   Summary

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 5708/P005US/08008819 from which the undersigned is authorized to draw.

Dated: February 5, 2004   Respectfully submitted,

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